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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,516	02/24/2004	George R. Borden IV	7146.0197	2749
55648	7590	03/27/2008		
KEVIN L. RUSSELL CHERNOFF, VILHAUER, MCCLUNG & STENZEL LLP 1600 ODS TOWER 601 SW SECOND AVENUE PORTLAND, OR 97204			EXAMINER HEFFINGTON, JOHN M	
			ART UNIT 2179	PAPER NUMBER
			MAIL DATE 03/27/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/786,516

Applicant(s)

BORDEN, GEORGE R.

Examiner

JOHN M. HEFFINGTON

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-5 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is in response RCE filing of 14 December 2007. Claims 2 and 6 have been cancelled. Claims 1, 3-5 and 7 have been amended. Claims 1, 3, 5 and 7 are pending and have been considered below.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 14 December 2007 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 1 and 5 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 3-5 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter

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which applicant regards as the invention. The claims claim both a product and a process, i.e. a graphical user interface and method steps. MPEP paragraph 2173.05(p) [R-5] Claim Directed to Product-By- Process or Product and Process part II states:

A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. *> IPXL Holdings v. Amazon.com, Inc., 430 F.2d 1377, 1384, 77 USPQ2d 1140, 1145 (Fed. Cir. 2005);< Ex parte Lyell, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990) *>

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3-5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sezan et al. (US 6,236,395 B1).

Claim 1: Sezan discloses a graphical user interface for a personal video recorder comprising:

- a. Simultaneously presenting on a display, a plurality of different key frames, each key frame associated with a respective different video separately recorded onto a storage medium of said personal video recorder, and representative of a clip

within the respectively associated different video, each video clip and key frame automatically selected by said personal video recorder by analyzing the content of the respectively associated video recorded on said storage (column 1, lines 29-41, column 4, lines 3-6, column 7, lines 56-63, column 8, lines 10-36, column 14, lines 7-40),

- b. Presenting on said display, a plurality of sequential frames of one of said video clips, beginning from the first frame of the presented one of said video clips, in response to a user selecting a key frame associated with the presented one of said video clips (column 4, lines 9-15, column 8, lines 10-36),

but does not disclose presenting title information, length information, quality information and source information regarding at least one of the presented one of said video clips and the video associated with the presented one of said video clips. However, Sezan discloses program profiles which define distinctive characteristics of the content of the program, such as actors, stars, rating, director, release date, time stamps, keyword identifications and categories which can be used for filtering in the search for video information. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to add presenting title information, length information, quality information and source information regarding at least one of the presented one of said video clips and the video associated with the presented one of said video clips to Sezan. One could have been motivated to add presenting title information, length information, quality information and source information regarding at least one of the

presented one of said video clips and the video associated with the presented one of said video clips to Sezan to facilitate the user in identifying a clip more accurately.

Claim 3: Sezan discloses the interface of claim 1 wherein said plurality of different key frames is presented in a two dimensional array (figures 5 and 9).

Claim 4: Sezan discloses the interface of claim 1 but does not disclose the selection of one of said video clips is based upon, at least in part, the selection of a second video clip. However, Sezan discloses selecting a video based upon a program description wherein the program description scheme identifies the contents of a second video segment (claim 9). Sezan discloses identifying two related video clips associated with the same program description. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to add selection of one of said video clips is based upon, at least in part, the selection of a second video clip to Sezan. One could have been motivated to add selection of one of said video clips is based upon, at least in part, the selection of a second video clip to Sezan because Sezan discloses filtering video content based on user criteria and a user in Sezan may want to quickly scan clips of videos by the clips being played automatically consecutively.

Claim 5: Sezan discloses a graphical user interface for a personal video recorder comprising:

- a. Simultaneously presenting on a display, a plurality of different key frames, each key frame associated with a respective different video separately recorded onto a storage medium of said personal video recorder, and representative of a clip within the respectively associated different video, each video clip and key frame automatically selected by said personal video recorder by analyzing the content of the respectively associated video recorded on said storage (column 1, lines 29-41, column 4, lines 3-6, column 7, lines 56-63, column 8, lines 10-36, column 14, lines 7-40),
- b. Presenting on said display, a plurality of sequential frames of one of said video clips, beginning from the first frame of the presented one of said video clips, in response to a user selecting a key frame associated with the presented one of said video clips (column 4, lines 9-15, column 8, lines 10-36),

but does not disclose the selection of one of said video clips is based upon, at least in part, the selection of a second video clip. However, Sezan discloses selecting a video based upon a program description wherein the program description scheme identifies the contents of a second video segment (claim 9). Sezan discloses identifying two related video clips associated with the same program description. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to add selection of one of said video clips is based upon, at least in part, the selection of a second video clip to Sezan. One could have been motivated to add selection of one of said video clips is based upon, at least in part, the selection of a second video clip to

Sezan because Sezan discloses filtering video content based on user criteria and a user in Sezan may want to quickly scan clips of videos by the clips being played automatically consecutively.

Claim 7: Sezan discloses the interface of claim 5 wherein said plurality of different key frames is presented in a two dimensional array (figures 5 and 9).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Heffington whose telephone number is (571) 270-1696. The examiner can normally be reached on Mon - Fri 8:00 - 5:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMH
3/17/08

/Ba Huynh/

Primary Examiner, Art Unit 2179